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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/683,789	10/10/2003	Hoa La Wilhelm	KC-19204	1789

7590 04/05/2005

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EXAMINER

YU, MELANIE J

ART UNIT PAPER NUMBER

1641

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/683,789

Applicant(s)

WILHELM ET AL.

Examiner

Melanie Yu

Art Unit

1641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

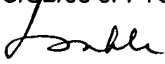
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1,3-26 and 28.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


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03/31/05



Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that rejection of claims 1, 3-26 and 28 under 35 USC 112, first paragraph is improper because the negative limitation recited in claims 1, 10, 20 and 28 is properly supported by the instant specification even though the negative limitation is not specifically recited in the specification. However, the caselaw cited by Applicant, MPEP 2173.05(i), is not relevant to a rejection of new matter under 35 USC 112, first paragraph, and rather refers to a scope of enablement rejection. Furthermore, in the case of *In Re Johnson*, it is stated that the excluded species are part of a genus and therefore the genus can be claimed with an exclusion of a particular species. In the instant specification, the hydrogen ions and ion aggregates are not part of a recited species, and the remaining species are not sufficient to support any mammalian substance excluding a hydrogen ion or ion aggregate. Applicant is referred to the relevant new matter rejection MPEP 2173.05(i), which states "any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 USC 112, first paragraph as failing to comply with the written description requirement. Therefore, Applicant's negative limitation is not supported by the instant specification and a new matter rejection is proper.

Applicant argues that rejections of claims 1, 3-11, 14-20, 22-26 and 28 under 35 USC 103(a) are not proper over Diehl et al. (US 2003/0158530) in view of Ponce et al. (Critical Revision of Presumptive Tests for Bloodstains) and Rittersdorf et al. (US 3,917,452) because Diehl et al. cannot preclude the detection of hydrogen ions or ion aggregates, and cannot be modified to measure any parameter other than ionic strength. Applicant further argues that Diehl et al. cannot be relied upon to show obviousness to preclude the detection of hydrogen ions or ion aggregates. As noted in the previous office action dated 9 February 2005, Examiner recognizes that Diehl et al. teach detection of a hydrogen ion or ion aggregate. However, Diehl et al. is relied upon only for structural aspects, and not for the detection of hydrogen ions or ion aggregates. As described in the office action dated 9 February 2005, Ponce et al. and Rittersdorf et al. provide for the detection of blood in a sample in order to diagnose hemorrhages instead of detecting ion aggregates or hydrogen ions. Therefore, the device would not be inoperable and it would be obvious to alter the intended purpose of the device to detect blood instead of hydrogen ions or ion aggregates.

Applicant argues that the reagents taught by Ponce et al. cannot be substituted for the reagents taught by Diehl et al. because the reagents of Ponce et al. are not effective for detecting and measuring ionic strength in urine. However, it would be obvious to substitute the reagents of Ponce et al. in the device of Diehl et al. in order to detect blood in a sample instead of hydrogen ions or ion aggregates, and would render the device of Diehl et al. capable of detecting blood. Applicant further argues that the substitution of reagents of Ponce et al. would a) completely change the principle of operation of the Diehl et al. device, and b) render the Diehl et al. device inoperable for its intended purpose of measuring ionic strength in urine. However, the structural limitations of the device of Diehl et al. are capable of accommodating the reagents of Ponce et al., and one would be motivated to do so in order to detect blood in a sample as taught by Rittersdorf et al. The substitution of the reagents of Ponce et al. in the device of Diehl et al. would not detect ionic strength, but would rather detect blood in a sample and the device would not be inoperable. Regarding Applicant's argument that Rittersdorf does not teach reagents capable of detecting and measuring ionic strength, Rittersdorf is not relied upon for the detection of hydrogen ions or ion aggregates. As discussed above, Rittersdorf et al. provide motivation to apply the reagents of Ponce et al. to the device of Diehl et al. to detect blood.

Applicant argues that the rejection of claims 10, 12, 13, 20 and 21 under 35 USC 103(a) over Springer et al. (US 6,617,488) in view of Ponce et al. and Rittersdorf et al. is not proper because Springer et al. cannot be modified to preclude the detection of hydrogen ions and to do so would render the disclosed method and apparatus inoperable for their intended purpose. However, it would have been obvious in view of Rittersdorf et al. to include the reagents of Ponce et al. to detect blood and alter the intended purpose of Springer et al. to detect blood in a sample instead of hydrogen ions or ion aggregates. Springer et al. is relied upon for structural limitations and not detection of hydrogen ions or ion aggregates.